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09/823,626	03/30/2001	David K. Braverman	COS99036	6953

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EXAMINER

LEROUX, ETIENNE PIERRE

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Please find below and/or attached an Office communication concerning this application or proceeding.



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09/823,626

March 30, 2001

Braverman, David

COS 99036

EXAMINER

Etienne LeRoux

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2161

3/10/2006

DATE MAILED:

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Commissioner for Patents

Attached is Examiner's Answer and FORM PTO-1449

3/10/2006



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Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/823,626
Filing Date: March 30, 2001
Appellant(s): BRAVERMAN, DAVID K.

Margo Livesay
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 1, 2006 appealing from the Office action mailed May 20, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Pat. No. 5,787,416, Tabb et al., Jul. 28, 1998

Pub. No. US 2002/0026410, Woloshin et al, Feb 28, 2002

Pub No US 2002/0131561, Gifford et al., Sep. 19, 2002

Pub No US 2001/0047347, Perell et al, November 29, 2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims Status

Claims 1-34 are pending. Claims 1-34 are rejected as detailed below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,787,416 issued to Tabb et al (hereafter Tabb), in view of Pub No US 2002/0026410

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issued to Woloshin et al (hereafter Woloshin and further in view of Pub No US 2002/0131561

issued to Gifford et al (hereafter Gifford).

Claims 1, 6, 11, 16, 21, 26 and 32:

Tabb discloses:

storing account information of a plurality of customers in a database, the account information including information for associating each of the plurality of customers with a particular agent among a plurality of agents [Tabb: sales representative reads on a particular agent, col 17, lines 48-60];

generating a list of customer accounts corresponding to the particular agent from the account information [Tabb: each representative is associated with a list of customers and each customer is associated with a list of orders, col 17, lines 48-60]

displaying the list via a web browser to the agent [Tabb: a hypertext report is available for a browse sequence, col 3, line 64 – col 4, line 5]

Tabb discloses the essential elements of the claimed invention as noted above but does disclose **detecting an event that changes an association between one of the customers and the particular agent**. Woloshin discloses detecting an event that changes an association between one of the customers and the particular agent [Woloshin: event is receipt of application, paragraph 20]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tabb to include detecting an event that changes an association between one of the customers and the particular agent as taught by Woloshin for the purpose of informing a sales representative that a new application has been processed [Woloshin: paragraphs 7, 20]. Furthermore, the ordinarily skilled artisan would have been motivated to

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improve Tabb's invention per the above limitation such that a representative's customer list can be updated [Tabb: col 17, lines 53-57]

The combination of Tabb and Woloshin discloses the essential elements of the claimed invention as noted above but does not disclose **determining whether the particular agent has enabled notification of account changes and in response to detecting the event and determining that the particular agent has enabled notification of account changes, generating an electronic mail message describing the event and sending the electronic mail message to the particular agent**. Gifford discloses determining whether the particular agent has enabled notification of account changes and in response to detecting the event and determining that the particular agent has enabled notification of account changes, generating an electronic mail message describing the event and sending the electronic mail message to the particular agent [Gifford, paragraph 155, Fig 5, step 520 and paragraph 156, Fig 5, step 570]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Tabb and Woloshin to include determining whether the particular agent has enabled notification of account changes and in response to detecting the event and determining that the particular agent has enabled notification of account changes, generating an electronic mail message describing the event and sending the electronic mail message to the particular agent as taught by Gifford for the purpose providing the sales representative with an update regarding his/her customer list such that the sales representative can schedule appropriate follow-up actions with the customer [Tabb: col 17, lines 53-57 discloses a list of customers which a representative services].

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Claims 2, 7, 12, 17, 22 and 27:

The combination of Tabb, Woloshin and Gifford discloses the elements of claims 1, 6, 11, 16, 21, and 26 as noted above and furthermore, Tabb discloses drilling down to view a particular customer invoice associated with a particular customer account selected from the list [Fig 3f]

Claims 3, 8, 13, 18, 23, 28 and 33 :

The combination of Tabb, Woloshin and Gifford discloses the elements of claims 1, 6, 11, 16, 21, and 26 as noted above but does not disclose wherein the event includes a new enrollment of the one of the customers or an account cancellation of the one of the customers. Woloshin discloses wherein the event includes a new enrollment of the one of the customers or an account cancellation of the one of the customers [paragraph 20]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein the event includes a new enrollment of the one of the customers or an account cancellation of the one of the customers as taught by Woloshin for the purpose of informing a sales representative that a new application has been processed [paragraph 20]. The ordinarily skilled artisan would have been motivated to improve the above combination of references per the above for the purpose of sending an e-mail to the representative in order to create an on-line application processing system [paragraph 17].

Claims 4, 9, 14, 19, 24 and 30:

The combination of Tabb, Woloshin and Gifford discloses the elements of claims 1, 6, 11, 16, 21 and 26 as noted above and furthermore, Gifford discloses displaying at least one

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option to the particular agent for selectively enabling or disabling the notification of account changes [paragraphs 154 and 155]

Claims 5, 10, 15, 20, 25 and 31:

The combination of Tabb, Woloshin and Gifford discloses the elements of claims 1, 6, 11, 16, 21 and 26 as noted above and furthermore, Tabb discloses wherein the customer account in the storing step is associated with a user identification of the particular agent [employee ID serves as primary key for the representative, col 18, lines 50-60].

2. Claims 29 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tabb, Gifford and Woloshin and further in view of Pub No US 2001/0047347 issued to Perell et al (hereafter Perell).

Claims 29 and 34:

The combination of Tabb, Woloshin and Gifford discloses the elements of claims 26 and 32 as noted above but fails to disclose e-mail notification mechanism enabling a sales representative to specify automatic receipt of e-mail notification message when a customer cancels an e-billing customer account. Woloshin discloses an e-mail notification mechanism to notify a sales representative [par 20]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tabb to include an e-mail notification mechanism as taught by Woloshin for the purpose of informing a sales representative of a new customer [par 20]. The ordinarily skilled artisan would have been motivated to improve the invention of Tabb per the above for the purpose of sending an e-mail to the representative in order to create an on-line application processing system [par 17].

The combination of Tabb and Woloshin disclose the elements of claim 29 except for the automatic receipt of an e-mail notification when a customer cancels an e-billing account. Perell discloses automatic receipt of e-mail notification when a customer cancels an e-billing account [par 311]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Tabb and Woloshin to include automatic receipt of e-mail notification when a customer cancels an e-billing account for the purpose of informing a company representative that an existing account has been cancelled. The ordinarily skilled artisan would have been motivated to modify the combination of Tabb and Woloshin per the above for the purpose of sending an e-mail to the representative in order to create an on-line application processing system [par 17].

Response to Arguments

Appellant's arguments filed 2/1/2006 have been carefully considered but are not persuasive for the reasons given below:

Appellant Argues:

Appellant argues in the second paragraph of page 15:

Thus, Gifford et al sends email to a subscriber only when a sender has already initiated a process of leaving a message, and the email that is sent to the subscriber is merely a notification of a message received from a sender. The subscriber may enable notification via email of an already received message, in stark contrast to "determining whether the particular agent has enabled notification of account changes; and in response to detecting the event and determining that the particular agent has enabled notification of account changes, generating an electronic mail

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message describing the event and sending the electronic mail message to the particular agent,” as recited by claim 1 of the present invention. Therefore, Gifford et al does not suggest or disclose these features as urged by the Examiner, and the combination of Tabb et al., Gifford et al., and Woloshin et al., does not cure this deficiency.

Examiner Responds:

Examiner is not persuaded. The above limitation is clearly mapped to the disclosure of Gifford in above Office action. Nevertheless, for convenience of the reader, paragraphs 155 and 156 of Gifford’s disclosure is given below:

[0155] If step 520 determines that e-mail notifications have been enabled, then control passes to step 540. In step 540, the system gathers the information about the message for which the notification is being generated. This includes message type, length, sender and at what time it was left. Subsequently, control passes to step 550 where the system makes a second decision. In step 550, the system determines if a subscriber has enabled receipt of enriched (or active) e-mails. If step 550 determines that enriched e-mails have not been enabled, the control passes to step 560. In step 560, the message is converted to a facsimile or audio format directly without using an active interface. The message is converted to the format preferred by the subscriber. For a FAX messages the supported formats are multi-page TIFF or PDF. For voice messages it can be AU, WAV, GSM, or RealAudio.

[0156] However, if step 550 determines that enriched e-mails are enabled, then control passes to step 570 which causes the system to generate an enriched email containing status information and a link back to the message. In one embodiment of the present invention, the e-mail is generated by merging message information and an HTML template. Regardless of the decision reached in step 550, after both steps 570 and 560, control passes to step 580. In step 580, the system generates an e-mail addressed to the subscriber's e-mail account. Such an e-mail can be formatted in any valid format; however, the preferred embodiment utilizes MIME encoding format. Lastly, in steps 590 and 595, respectively, the e-mail notification is sent (e.g., using the SMTP protocol) and the process ends.

Examiner maintains the above disclosure by Gifford reads on the claim limitation “determining whether the particular agent has enabled notification of account changes; and in response to detecting the event and determining that the particular agent has enabled notification

of account changes, generating an electronic mail message describing the event and sending the electronic mail message to the particular agent.”

Appellant Argues:

Appellant states in the third paragraph of page 15;

Moreover, the Examiner (Office Action dated May 20, 2005, p. 3) contends that Tabb et al discloses “displaying the list via a web browser to the agent [inherently disclosed because a hypertext report is available for a browse sequence, col. 3, lines 64 – col. 4, line 5, and a report shows a list of customer orders for a particular sales representative, col 17, lines 48-60].”

Appellant respectfully submits that mention of a “hypertext report,” especially in the context of Tabb et al., do not inherently disclose “displaying the list via a web browser” as urged by the Examiner, as inherency requires that the missing descriptive material is “necessarily present,” not merely probable or possible present in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 19560-51 (Fed. Cir. 1999) (citing Continental Can Co. USA, Inc v Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). There are numerous ways other than web browsers to display hypertext reports, and Tabb et al does not mention or suggest use of any type of web browser and thus the feature is not inherently disclosed.

Examiner Responds:

Examiner is not persuaded. Tabb discloses the following in column 3 line 64 through column 4, line 5:

Moreover, since the hypertext report is generated electronically, the entire process may be automated so that an electronic copy of a hypertext report may be automatically generated and delivered on a timely basis (e.g., daily). By placing report information in hypertext format, the

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system of the present invention allows the reader to employ other features of Hypertext, such as "Content" and "Search" generation, Browse sequences, Topic breaks, and the like.

Tabb discloses a hypertext report which allows other features such as content and search generation and browse sequences, topic breaks and the like. A common dictionary¹ defines browse sequences per the following:

Web browser:

Software that lets a user view HTML documents and access files and software related to those documents. Originally developed to allow users to view or browse documents on the World wide Web, **Web browsers** can blur the distinction between local and remote resources for the user by also providing access to documents on an internet or intranet, or the local hard drive.

Web browser software is built on the concept of hyperlinks, which allow users to point and click with a mouse in order to jump from document to document in whatever order they desire. Most **Web browsers** are also capable of downloading and transferring files providing access to newsgroups, displaying graphics embedded in the document, playing audio and video files associated with the document, and executing small programs such as Java applets or ActiveX controls included by programmers in the documents. **Also called browser.**

Examiner maintains that a web browser is inherent in the disclosure of Tabb because a common dictionary equates a browser as disclosed by Tabb to a Web browser per the above.

Tabb's disclosure includes a hypertext report. A common dictionary² defines hypertext per the following:

HTML:

A common dictionary³ defines Hypertext per the following:

HTML: Acronym for **HyperText Markup Language**. The markup language used for documents on the World Wide Web. A tag-based notation language used to format documents that can then be interpreted and rendered by an **Internet Browser**. **Web browsers** should display these elements to the user and should responds to user actions such as activation of a link by means of

¹ Microsoft Computer Dictionary, Fifth Edition

² Microsoft Computer Dictionary, Fifth Edition

³ Microsoft Computer Dictionary, Fifth Edition

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a key press or mouse click. HTML 2, defined by the Internet Engineering Task force (IETF), included features of HTML common to all **Web browsers** as of 1994 and was the first version of HTML widely used on the World Wide Web.

Examiner maintains that a web browser is inherent in the disclosure of Tabb because a common dictionary of hypertext (HTML) as taught by Tabb requires a web browser for display of hypertext per the above.

Online Help System:

Tabb discloses the following in column 15, lines 28-30:

Today, hypertext documents are commonplace. Most users are familiar with the hypertext links in online help systems, such as WinHelp, the online help system for Microsoft Windows.

The Microsoft Computer Dictionary provides the following regarding online:

In reference to one or more computers connected to a network. In reference to a user, currently connected to the Internet.

Appellant Argues:

Appellant includes the following in the first paragraph of page 17:

Using the examiner's reasoning, Tabb et al's executive would be sent an e-mail message when "a new application has been processed," in contravention of at least one of the advantages stated by Tabb et al. Obviousness rejections require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references.

Examiner Responds:

Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the

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rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant concludes based on an undisclosed source (emphasis added) that Tabb's executive would be sent an e-mail message in contravention of at least one of the advantages stated by Tabb. Examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant (Appellant) cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

Furthermore, examiner is not persuaded by Appellant's characterization of "detail information which is not interesting" to a busy executive. Because customers are the life blood of any business, a busy executive would always be interested in receiving information about the status of customer relations especially if a existing customer were lost. Examiner does not agree that Tabb teaches away from the present invention. Furthermore, Tabb requires information on a timely basis and thus automatically generated emails concerning the status a customer is consistent with the disclosure by Tabb of "timely reports."

Appellant Argues:

Appellant argues on pages 18-21 that none of the references individually, nor in any reasonable combination, cures the deficiencies of the applied references previously discussed with regard to independent claims 1, 6, 11, 16 21 26 and 32 from which each of claims 2-5, 7-10, 12-15, 17-20, 22-25, 27-31 and 33-34 depend.

Examiner Responds:

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Examiner is not persuaded. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Furthermore, the elements of the relevant claims are considered in above Office Action. However, examiner will specifically consider the following argument by Appellant which is included in the first paragraph of page 21:

The system includes computer databases and interactive Internet based server systems. (Abstract) When a member cancels his/her membership on-line, a e-mail is sent to the member's registered email account with notice of the cancellation, thus informing the member of his/her own account cancellation, again in stark contrast to the features recited by claims 29 and 34, which require that an e-mail notification be sent to a sales representative associated with a customer upon cancellation of an e-billing enrollment of the customer, or deletion of the customer from the e-billing system, as required by claims 29 and 34, respectively.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant has correctly reproduced the pertinent teaching or Perell regarding the generation and sending of an electronic mail message. Tabb discloses the following, column 17, line 48 through column 18, line 5, regarding a sales representative.

Consider, as another example, a report which lists the sales by sales representative (i.e., employee). Such a report would include summary information which specifies how much a given sales representative sold. Also, summary information could be provided to list sales representatives for a given region. The overall structure for such a report is as follows. At the highest level, the report presents a directory of sales representatives. Each sales representative, in turn, is associated with a list of customers which that particular sales representative services. Finally, each customer would have a list of orders which that customer has placed. The

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information in the desired report, although it may come from different database tables, is nonetheless related.

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In a conventional approach to creating such a report, all of the reports would be generated and printed individually. Then, the individual reports would be pasted together and placed in a booklet. Since each report is generated separately, information cannot be presented in ways which allow users to quickly locate detailed information of interest; there is no opportunity to hide uninteresting details. As will now be described, the present invention allows information which would typically be presented as different reports to be combined into a single hypertext report (or multiple reports with interreport hypertext crosslinks).


Tabb discloses per the above, sending an electronic report to a sales representative but does not disclose sending an electronic mail message to a sales representative. Perell discloses sending an electronic mail message following an event such as the cancellation of an account/membership. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tabb and Perell for the purpose of sending an e-mail to the representative in order to create an on-line application processing system [Perell, paragraph 17].

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:


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